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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,700	10/10/2001	Keith J. Allison	BIN-105US	9323

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07/02/2003

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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 07/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,700

Applicant(s)

ALLISON ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 9-12 and 17-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-9 and 13-14, respectively, of U.S. Patent No. 6,344,498 (Allison et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

The present application is a continuation-in-part of Allison et al. There is significant overlap between the claims of Allison et al. and the present claims. Allison et al. disclose water-based erasable marking composition comprising water, pigment, glycerin, and polyurethane as well as an application instrument comprising the composition. In fact, the only difference between Allison et al. and the present claims is that the present claims require polyurethane which has viscosity which increases by at least a factor of 10 when the polyurethane is dried from 30% dispersion of the polyurethane in water to a 65% polyurethane dispersion in water while Allison et al. broadly disclose the use of polyurethane.

Therefore, the scope of the claims of Allison et al. is generic with respect to the scope of the cited present claims. Such a generic disclosure clearly encompasses the use of all polyurethane including those present claimed. Thus, applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to col.8, lines 40-45 of Allison et al. which discloses that the polyurethane utilized is known under the tradename Dispercoll such as Dispercoll U KA 848 1, Dispercoll DC53 and Dispercoll DC54. Similarly, using the specification of the present invention as a dictionary, it is noted that the polyurethane utilized in the present invention which has viscosity which increases by at least

a factor of 10 when the polyurethane is dried from 30% dispersion of the polyurethane in water to a 65% polyurethane dispersion in water as set forth in the present claims is known under the tradename Dispercoll such as Dispercoll U KA 848 1, Dispercoll DC53 and Dispercoll DC54 (page 23, last paragraph). Thus, it is clear that the polyurethane claimed by Allison et al. encompasses the polyurethane presently claimed.

In light of the above, it is clear that it would have been obvious to one of ordinary skill in the art to arrive at the present claims from the copending ones.

3. Claims 5-8 and 20 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,344,498 (Allison et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

The present application is a continuation-in-part of Allison et al. There is significant overlap between the claims of Allison et al. and the present claims. Allison et al. disclose water-based erasable marking composition comprising water, pigment, glycerin, and polyurethane as well as an application instrument comprising the composition.

The difference between Allison et al. and the present claimed invention is the requirement in the claims of (a) amount of polyurethane and (b) specific type of polyurethane.

With respect to difference (a), it is noted that the amount of polyurethane presently claimed, i.e. 26-42.5%, is broader than the amount of polyurethane disclosed in the claims of Allison et al., i.e. greater than 30% to 42.5%.

However, one of ordinary skill in the art would have recognized that the amount of polyurethane disclosed by Allison et al. squarely falls within and almost completely overlaps the amount presently claimed and thus, it would have been obvious to, as well as within the bounds of routine experimentation, for one of ordinary skill in the art to use amount of polyurethane, including that presently claimed, and thereby arrive at the claimed invention.

With respect to difference (b), it is noted that the scope of the claims of Allison et al. is generic with respect to the scope of the cited present claims. Such a generic disclosure clearly encompasses the use of all polyurethane including those present claimed. Thus, applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to col.8, lines 40-45 of Allison et al. which discloses that the polyurethane utilized is known under the tradename Dispercoll such as Dispercoll U KA 848 1, Dispercoll DC53 and Dispercoll DC54. Similarly, using the specification of the present invention as a dictionary, it is noted that the polyurethane utilized in the present invention which has viscosity which increases by at least a factor of 10 when the polyurethane is dried from 30% dispersion of the polyurethane in water to a 65% polyurethane dispersion in water as set forth in the present claims is known under the

tradename Dispercoll such as Dispercoll U KA 848 1, Dispercoll DC53 and Dispercoll DC54 (page 23, last paragraph). Thus, it is clear that the polyurethane claimed by Allison et al. encompasses the polyurethane presently claimed.

In light of the above, it is clear that it would have been obvious to one of ordinary skill in the art to arrive at the present claims from the copending ones.

4. Claims 1-4, 19 and 13-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 10-12, respectively, of U.S. Patent No. 6,344,498 (Allison et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

The present application is a continuation-in-part of Allison et al. There is significant overlap between the claims of Allison et al. and the present claims. Allison et al. disclose water-based erasable marking composition comprising water, pigment, glycerin, and polyurethane as well as an application instrument comprising the composition.

The difference between Allison et al. and the present claimed invention is the requirement in the claims of (a) amounts of water, pigment, glycerin, and polyurethane and (b) specific type of polyurethane.

With respect to difference (a), it is noted that the amounts of water, pigment, glycerin, and polyurethane presently claimed are broader than the amounts of water, pigment, glycerin, and polyurethane in the claims of Allison et al.

However, one of ordinary skill in the art would have recognized that the amounts disclosed by Allison et al. fall squarely within the corresponding amounts presently claimed and thus, it would have been obvious to, as well as within the bounds of routine experimentation, for one of ordinary skill in the art to use amounts of water, pigment, glycerin, and polyurethane, including those presently claimed, and thereby arrive at the claimed invention.

With respect to difference (b), it is noted that the scope of the claims of Allison et al. is generic with respect to the scope of the cited present claims. Such a generic disclosure clearly encompasses the use of all polyurethane including those present claimed. Thus, applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to col.8, lines 40-45 of Allison et al. which discloses that the polyurethane utilized is known under the tradename Dispercoll such as Dispercoll U KA 848 1, Dispercoll DC53 and Dispercoll DC54. Similarly, using the specification of the present invention as a dictionary, it is noted that the polyurethane utilized in the present invention which has viscosity which increases by at least a factor of 10 when the polyurethane is dried from 30% dispersion of the polyurethane in water to a 65% polyurethane dispersion in water as set forth in the present claims is known under the

tradename Dispercoll such as Dispercoll U KA 848 1, Dispercoll DC53 and Dispercoll DC54 (page 23, last paragraph). Thus, it is clear that the polyurethane claimed by Allison et al. encompasses the polyurethane presently claimed.

In light of the above, it is clear that it would have been obvious to one of ordinary skill in the art to arrive at the present claims from the copending ones.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Imagawa et al. (U.S. 5,716,217) discloses water-base erasable ink and marking pen comprising the ink wherein the ink comprises not less than 30% water, 0.5-30% polyurethane, not more than 20% pigment, and not more than 20% glycerin. However, there is no disclosure or suggestion of polyurethane which has viscosity which increases by at least a factor of 10 when the polyurethane is dried from 30% dispersion of the polyurethane in water to a 65% polyurethane dispersion in water as require in all the present claims.

Inoue et al. (U.S. 5,712,328) disclose water-base ink and marking pen comprising the ink wherein the ink comprises 50-90% water, 1-30% pigment, 1-40% glycerin, and 0.05-60% polyurethane. However, there is no disclosure or suggestion of polyurethane which has viscosity which increases by at least a factor of 10 when the polyurethane is dried from 30% dispersion of the polyurethane in water to a 65% polyurethane dispersion in water as require in all the present claims. Further, there is no explicit disclosure that the ink is erasable.

Nakamura et al. (U.S. 5,854,320) disclose water-base erasable ink and marking pen comprising the ink wherein the ink comprises 50-90% water, 0.1-30% pigment, not more than 20% glycerin, and 0.1-15% polyurethane. However, there is no disclosure or suggestion of polyurethane which has viscosity which increases by at least a factor of 10 when the polyurethane is dried from 30% dispersion of the polyurethane in water to a 65% polyurethane dispersion in water as require in all the present claims.

Nakanishi et al. (U.S. 5,412,021) disclose water-base erasable ink and marking pen comprising the ink wherein the ink comprises 50-90% water, 0.5-20% pigment, not more than 20% glycerin, and 0.1-15% polyurethane. However, there is no disclosure or suggestion of polyurethane which has viscosity which increases by at least a factor of 10 when the polyurethane is dried from 30% dispersion of the polyurethane in water to a 65% polyurethane dispersion in water as require in all the present claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
June 26, 2003